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One Metropolitan Square Suite 2600
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EXAMINER

CHARLES, DEBRA F

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/558,980

Applicant(s)

WILLIAMS ET AL.

Examiner

Debra F. Charles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-43 and 45-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-43 and 45-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 21 January 2004 has been entered.

Response to Amendment

2. Claims 1,2,3,6,10,11,12,13,14,15,16,26,27,28,34,45,50,51,52, and 66 have been amended. Claims 9 and 44 have been cancelled.

Response to Arguments

3. Applicant's arguments with respect to claims 1-8, 10-43 and 45-67 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1, 34 and 66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner requests attorney adjust the phrase “storing in a database a plurality” since goods are not stored in a database. Data is stored in a database.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 67 is rejected under 35 U.S.C. 101 because the bodies of the claims do not recite technology, i.e. computer implementation or any other technology in a non-trivial manner. *In re Toma*, 197 USPQ 852 (CCPA 1978). *Ex parte Bowman* 61 USPQ2D 1669.

For a claim to be statutory under 35 USC 101 the following two conditions must be met:

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1) The claimed invention must produce a “useful, concrete, tangible result” (*In re Alappat*, 31USPQ2d 1545, 1558 (Fed. Cir. 1994) and *State Street vs. Financial Signature Group Inc.*, 47 USPQ2d 1596’ 1601-02 (Fed Cir. 1998));

AND

2) The claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. Pat. App. & Inter. 2001)).

As to the technology requirement, note MPEP 2106 IV B 2(b). Also note *In re Waldbaum*, 173USPQ 430 (CCPA 1972) which teaches “useful arts” is synonymous with “technological arts”. In *Musgrave*, 167USPQ 280 (CCPA 1970), *In re Johnston*, 183USPQ 172 (CCPA 1974), and *In re Toma*, 197USPQ 852 (CCPA 1978), all teach a technological requirement.

In *State Street*, “in the technological arts” was never an issue. The invention in the body of the claim must recite technology. If the invention in the body of the claim is not tied to technological art, environment, or machine, the claim is not statutory. *Ex parte Bowman* 61USPQ2d 1665,1671 (BD. Pat. App. & Inter.2001)(Unpublished).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1,4,6,7,8,10,11,12,13,14,15,21, 22,29,33, 34,39,40,41,42,43,45,46,47, 48,49,53,64,65,66 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jost et al.(U.S. 5361201A).

Re claims 1, 34, 66 and 67: Jost et al. disclose a method for providing a value of a good to a requester(Abstract), said method comprising the steps of:

storing in a database a plurality of goods including a description of each good(col. 4, lines 20-40, col. 6, lines 5-30);

assigning a policy value to at least one good stored in the database(col. 6, lines 5-30);

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uploading data to a computer including a request for a value of a good and data relating to the good, the computer configured as a calculator for calculating a value of the good(Abstract, col. 6, lines 5-30, col. 12, lines 1-15);

using the computer to determine whether the value of the good can be calculated based on the uploaded data determining whether the good has a policy value[routine value] assigned thereto(col. 7, lines 5-45);

analyzing trends among a plurality of similar exception requests[value other than routine value](Abstract, col. 5, lines 10-25, col. 13, lines 40-60, col. 13, lines 40-65);

calculating the value of the good(Abstract, col. 14, lines 10-35); and

displaying the value of the good(col. 6, lines 20-35).

And at least one computer(Abstract, col. 4, lines 20-35, i.e. mainframe or PC are both servers, col. 6, lines 5-30, col. 12, lines 1-15);

a database for storing a plurality of goods including a description of each good and whether a policy value has been assigned to the good(col. 4, lines 20-35);

a server coupled to said database and configured to read input data including a request for a value of the good and data relating to the good, said server further configured to determine whether the value of the good can be calculated based on the inputted data including determining whether the good has a policy value assigned thereto(Abstract, col. 4, lines 20-35, i.e. mainframe or PC are both servers, col. 6, lines 5-30, col. 12, lines 1-15),

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a network connecting said server to said computer(col. 3, line 60-col. 4, line 40); and

a user interface allowing a requester to input data relating to a request for the value of the good and data relating to the good and receive the value of the good output(col. 3, line 60-col. 4, line 40).

Jost et al. disclose(s) the claimed invention except designating the request for the value of the good as an exception request[different from routine value] if no response is provided by the computer to the request for the value of the good; and inputting at least one new policy value[routine value] for a good based on the exception request[value other than routine value] analysis; recognize the request for the value of the good as an exception request if no response is provided by the system to the request for the value of the good . However, in col. 7, lines 5-45, col. 12, lines 1-45 thereof, Jost et al. disclose(s) neural networks learn from existing data and comparing the data, effectively defining exceptions to existing data. When the composite pricing system identifies data that is an exception to the norm, the neural network incorporates that exception into its analysis and adjusts the norm accordingly. Thus, a neural net creates new data[new policy value for a good] based on the exception data identified. Thus, it would have been obvious to one with an ordinary level of skill in the art to employ computer generated composite pricing to get the benefit of prices that take into account all the underlying components.

Re claim 4: Jost et al. disclose said step of uploading data comprises the step of accessing a computer configured as a server (Abstract, col. 4, lines 20-35, i.e. mainframe or PC are both servers, col. 6, lines 5-30, col. 12, lines 1-15).

Re claim 39: Jost et al. disclose uploading data to a computer comprises the step of uploading data to a computer including a request for a value of equipment and data relating to the equipment, the computer configured as a calculator for calculating the value of the equipment (Abstract, col. 6, lines 5-30, col. 12, lines 1-15, i.e. whether the item is a good, equipment or real estate would not matter to a composite pricing system that uses various factors to arrive at a price).

Re claim 40: Jost et al. disclose said server is configured to read input data relating to lease information (Abstract, col. 6, lines 5-30, col. 12, lines 1-15, col. 14, lines 10-35, i.e. reading input data is an inherent function of a computer system).

Re claims 6 and 41: Jost et al. disclose uploading data to a computer including a request comprises the step of loading into the computer at least one field configured for receiving and storing a new request for a value of a good (Abstract, col. 6, lines 5-30, col. 12, lines 1-15).

Re claims 7 and 42: Jost et al. disclose of loading at least one field comprises the step of loading at least one field configured for editing the new request (Abstract, col. 6, lines 5-30, col. 12, lines 1-15, col. 14, lines 10-35, i.e. editing a request is withdrawing or changing a request and does not change the uploading functionality).

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Re claims 8 and 43: Jost et al. disclose loading at least one field comprises the step of loading at least one field configured for withdrawing the request(Abstract, col. 6, lines 5-30, col. 12, lines 1-15, col. 14, lines 10-35, i.e. withdrawing a request is editing or changing a request and does not change the uploading functionality).

Re claim 45: Jost et al. disclose designating the request as an exception request comprises the step of loading at least one field configured for storing and submitting the exception request(Abstract, col. 6, lines 5-30, col. 7, lines 5-45,col. 12, lines 1-15) and informing an analyst of the existence of the exception request(col. 7, lines 5-45, i.e. the neural network is the analyst and does recognize differences from the norm via the computerized comparison system).

Re claims 10 and 46: Jost et al. disclose designating the request as an exception request comprises the step of loading at least one field configured for receiving and storing additional information for calculating a value for the exception request(Abstract, col. 6, lines 5-30, col. 7, lines 5-45,col. 12, lines 1-15).

Re claim 11: Jost et al. disclose designating the request as an exception request comprises the step of loading at least one field configured for storing and submitting the exception request(Abstract, col. 6, lines 5-30, col. 7, lines 5-45,col. 12, lines 1-15) and informing an analyst of the existence of the exception request(col. 7, lines 5-45, i.e. the neural network is the analyst and does recognize differences from the norm via the computerized comparison system).

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Re claims 12 and 47: Jost et al. disclose designating the request as an exception request(Abstract, col. 6, lines 5-30, col. 7, lines 5-45,col. 12, lines 1-15) comprises the step of analyzing trends in similar exception requests(Abstract, col. 5, lines 10-25, col. 13, lines 40-60, col. 13, lines 40-65).

Re claims 13 and 48: Jost et al. disclose analyzing trends in similar exception requests comprises the step of triggering an analyst to add additional policy values(col. 7, lines 5-45,col. 14, lines 35-60 i.e. the neural network is the analyst and does recognize differences from the norm via the computerized comparison system, and it will alter the analytical system to reflect new values that are outside of the norm, and it makes recommendations based on whether the property is extremely non-conforming).

Re claim 14: Jost et al. disclose uploading data to a computer comprises the step of uploading data to a computer including a request for a value of equipment and data relating to the equipment, the computer configured as a calculator for calculating the value of the equipment(Abstract, col. 6, lines 5-30, col. 12, lines 1-15, i.e. whether the item is a good, equipment or real estate would not matter to a composite pricing system that uses various factors to arrive at a price).

Re claim 15: Jost et al. disclose uploading data to a computer comprises the step of uploading lease information to a computer, the computer configured as a calculator for calculating a value of the equipment(Abstract, col. 6, lines 5-30, col. 12, lines 1-15, i.e. whether the item is a good, equipment or real estate would not matter to a composite pricing system that uses various factors to arrive at a price, and whether the

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information is lease information or other pricing data would not matter since all parameters come into play for the composite pricing system).

Re claims 21 and 64: Jost et al. disclose uploading data further comprises a step of loading at least one field configured for receiving, storing and deleting information relating to a new good(Abstract, col. 6, lines 5-30, col. 12, lines 1-15, i.e. receiving, storing and deleting information is an inherent part of a database system).

Re claims 22 and 49: Jost et al. disclose calculating the value further comprises the step of calculating the value using at least one input policy value and input changes for calculating the value(Abstract, col. 6, lines 5-30, col. 7, lines 5-45,col. 12, lines 1-15, col. 14, lines 10-35).

Re claims 33 and 65: Jost et al. disclose step of displaying the value further comprises the step of displaying the value within a summary report(col. 5, lines 35-45, col. 6, lines 20-35).

Re claims 29 and 53: Jost et al. disclose step of calculating the value comprises the step of cloning an existing request(col. 7, lines 5-45).

9. Claims 2,3,35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jost et al. as applied to claims 1 and 34 above, and further in view of Dugan (U.S. PAT. 5857174A).

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Jost et al. disclose a step of uploading data to a computer including a request comprises the step of submitting the data including the request for a value of the good and data relating to the good to a computer(Abstract, col. 6, lines 5-30, col. 12, lines 1-15).

Jost et al. disclose(s) the claimed invention except via an Internet. However, in col. 6, lines 20-31 thereof, Dugan disclose(s) using an internet connection to transmit data. It would be obvious to one of ordinary skill in the art to modify the invention of Jost et al. based on the teachings of Dugan. The motivation to combine these Jost et al. and Dugan references is to effectively transmit data by using the internet.

10. Claims 5,16,26,27,28,38,50,51,52 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jost et al. as applied to claims 1 and 34 above, and further in view of Whitworth(U.S.PAT. 6622129B1).

Re claims 5,16,38, and 57: Jost et al. disclose(s) the claimed invention except of calculating the value further comprises the step of calculating the value from one of residual value, net realizable value, orderly liquidation value and purchase option value; and uploading data to a computer further comprises the step of receiving and storing data relating to at least one residual factor. However, in the Abstract, col. 1, lines 30-50, col. 3, lines 10-55, col. 7, lines 15-40, col. 8, lines 45-65 thereof, Whitworth disclose(s) residual value and receiving and storing factors that are used to calculate residual value. It would be obvious to one of ordinary skill in the art to modify the

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invention of Jost et al. based on the teachings of Whitworth. The motivation to combine these Jost et al. and Whitworth references is to enhance the efficiency of calculating residual value.

Re claims 26, 27, 28, 50, 51 and 52: Jost et al. disclose(s) the claimed invention except wherein said step of calculating the residual value of the good further comprises a step of calculating the residual value as using at least one of:

$$(((\text{base value}) + E \text{ base value modifiers}) * \text{residual value look up})$$

depreciation value look up, $[\text{cost} * \text{residual value look up}]$ and $[\text{depreciation value look up} * \text{residual value look up}]$

for a lease term.

And said step of calculating the net realizable value of the good comprises the step of calculating the net realizable value as using at least one of

$$(((\text{base value}) + E \text{ base value modifiers}) * \text{net realizable value look up}) * \text{depreciation value look up}, [\text{cost} * \text{net realizable value lookup}] \text{ and } [\text{depreciation value look up} * \text{net realizable value look up}]$$

for a lease term.

And step of calculating the purchase option value of a good comprises the step of calculating the purchase option value as using at least one of

$$[\text{residual value} + ((\text{cost}/\text{quantity}) * \text{purchase option value look up})] \text{ and}$$

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[residual value + (cost * purchase option value look up)]

for a lease term.

However, in Figs. 1-8, cols. 1 and 2, col. 5, lines 15-50, col. 6, col. 7, lines 1-40, thereof, Whitworth disclose(s) calculating residual values for leasing situations. It would be obvious to one of ordinary skill in the art to modify the invention of Jost et al. based on the teachings of Whitworth. The motivation to combine these Jost et al. and Whitworth references is to use one of the several methods of calculating residual value to ensure an accurate calculation that avoids losses at the end of the lease term.

11. Claim 17, 30,31,32,58,59 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jost et al. as applied to claims 1 and 34 above, and further in view of Quinn(U.S.PAT. 636022B1).

Re claims 17, 30, 31, 32,58,59 and 60: Jost et al. disclose(s) the claimed invention except uploading data further comprises the step of receiving and saving profile information of a new user; uploading profile information from one of personal data, login information, password information, role information, organization information and preferences; and analyzing the profile information.

However, in the Abstract, col. 2, lines 50-67, col. 5, lines 40-60, col. 7, lines 15-40, claim 1, thereof, Quinn disclose(s) submitting new user profile information, personal information such as email, name, identity and relationship, and determining if a user has a directory entry in the system reflecting analyzing the data uploaded from the user. It would be obvious to one of ordinary skill in the art to modify the invention of Jost et al.

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based on the teachings of Quinn. The motivation to combine these references is to enhance Jost et al.'s invention by uniquely identifying the user for later access.

12. Claims 18 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jost et al. as applied to claims 1 and 34 above, and further in view of Hartnett(U.S.PAT. 6064971A).

Jost et al. disclose(s) the claimed invention except uploading data further comprises the step of loading at least one field configured for receiving a comment with a request. However, in col. 19, lines 25-65,col. 20, lines 40-41,col. 22, lines 20-25, thereof, Hartnett disclose receiving comments and putting them on a disk or on another storage medium which is the same as uploading comments after being prompted to do so. It would be obvious to one of ordinary skill in the art to modify the invention of Jost et al. based on the teachings of Hartnett. The motivation to combine these references is to enable the invention to receive and store comments associated with the respective field.

13. Claims 19,20, 23,24,25, 54,55, 56,62 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jost et al. as applied to claims 1 and 34 above, and further in view of Ma et al.(U.S.PAT. 6347313B1).

Re claims 19,20,62 and 63: Jost et al. disclose(s) the claimed invention except step of uploading data further comprises the step of updating matrix values; and updating matrix values comprises the step of updating the matrix values from one of policy value, value stream and cell value. However, in the Abstract, col. 1, lines 15-25,

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col. 2, lines 20-40, col. 3, lines 1-45, col. 6, lines 50-67, col. 7, lines 15-30 thereof, Ma et al. disclose(s) matrix values and updating matrixes. It would be obvious to one of ordinary skill in the art to modify the invention of Jost et al. based on the teachings of Ma et al. The motivation to combine these Jost et al. and Ma et al. references is to use matrix values to cluster values together and make them easily calculated and accessible to the user.

Re claims 23,24,25,54,55 and 56: Jost et al. disclose(s) the claimed invention except wherein said step of calculating the value further comprises the step of querying existing requests; querying existing requests further comprises the step of querying predefined or customized requests; and querying customized requests further comprises the step of receiving criteria data for the customized request. However, in the Abstract, col. 2, lines 20-65, thereof, Ma et al. disclose querying different types of queries and this includes previously submitted queries to learn the status of the previously submitted query and use that to further calculate a value. It would be obvious to one of ordinary skill in the art to modify the invention of Jost et al. based on the teachings of Ma et al. The motivation to combine these Jost et al. and Ma et al. references is to permit enhanced querying features that handle routine as well as customized queries for retrieval based on specific data criteria.

14. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jost et al. as applied to claim 34 above, and further in view of Gill(U.S.PAT. 6577858B1).

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Jost et al. disclose(s) the claimed invention except said network is one of a wide area network and a local area network. However, in col. 11, lines 20-30, thereof, Gell discloses a WAN connected to a LAN in a network. It would be obvious to one of ordinary skill in the art to modify the invention of Jost et al. based on the teachings of Gell. The motivation to combine these Jost et al. and Gell references is to use the flexibility of a LAN connected to a WAN to get enhanced data throughput.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (703) 305-4718. The examiner can normally be reached on 9-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frantzy Poinvil can be reached on (703) 305-9779. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Debra F. Charles

Examiner

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FRANTZY POINVIL
PRIMARY EXAMINER
AU 3628